

REMARKS

The specification has been amended to correct matters of form. It is respectfully submitted that no new matter has been introduced.

Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Claim 1 has been amended for reasons unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification thereby not narrowing the scope of the claim, to detect infringement more easily, to enlarge the scope of infringement, to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.), to expedite the issuance of a claim of particular current licensing interest, to target the claim to a party currently interested in licensing certain embodiments, to enlarge the royalty base of the claim, to cover a particular product or person in the marketplace, and/or to target the claim to a particular industry.

Claims 12-27 have been added. Claims 1-3, 10, and 12-27 are now pending in this application. Claims 1 and 12 are the independent claims.

I. The Objection to the Specification

In the Office Action, the Specification was objected to because of an informality. The Specification has been amended to correct the informality. Reconsideration and withdrawal of this rejection is respectfully requested.

II. The Obviousness Rejection

Claims 1-3 and 10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Agahi-Kesheh (WO94/27376) in view of Dimos (U.S. Patent No. 6,096,127). These rejections are respectfully traversed.

None of the cited references, either alone or in any combination, establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in

the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." See MPEP § 2143.

Dimos allegedly illustrates a varactor in Fig. 9 with an **unfilled gap** between electrodes. See Fig. 9.

Independent claim 1 recites "each of the first and second voltage tunable dielectric varactors comprising a tunable dielectric layer capable of being operated at room temperature, wherein each of the first and second voltage tunable varactors comprise a first electrode and a second electrode, wherein the tunable dielectric layer **at least partially fills a gap** defined between the second electrode and the first electrode". Neither Agahi-Kesheh nor Dimos expressly or inherently teach or suggest "each of the first and second voltage tunable dielectric varactors comprising a tunable dielectric layer capable of being operated at room temperature, wherein each of the first and second voltage tunable varactors comprise a first electrode and a second electrode, wherein the tunable dielectric layer **at least partially fills a gap** defined between the second electrode and the first electrode".

Thus, even if there were motivation or suggestion to modify or combine the cited references (an assumption with which the applicant disagrees), and even if there were a reasonable expectation of success in combining or modify the cited references (another assumption with which the applicant disagrees), the cited references still do not expressly or inherently teach or suggest every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness.

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

III. Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter:

“None of the references of record alone or in combination disclose or suggest the combination of limitations found in the independent claims.

Namely, claims 1-3, and 10 are allowable because none of the references of record alone or in combination disclose or suggest “each of the first and second voltage tunable dielectric varactors comprising a tunable dielectric layer capable of being operated at room temperature, wherein each of the first and second voltage tunable varactors comprise a first electrode and a second electrode, wherein the tunable dielectric layer at least partially fills a gap defined between the second electrode and the first electrode”.

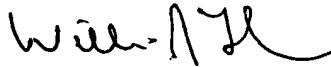
Claims 12-27 are allowable because none of the references of record alone or in combination disclose or suggest “a substantially planar projection of a tunable dielectric layer that is substantially parallel with and adjacent to the second side of the first electrode, the tunable dielectric layer electrically tunable at room temperature.”

CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

Enclosed is a USPTO Credit Card Payment Form filled out for \$ 394.00 to cover the fees associated with the addition of one independent claim, 15 dependent claims and the two month extension of time. If this is incorrect, the Commissioner is authorized to charge any fees which may be required for this paper to Deposit Account No. 50-1481.

Respectfully submitted,



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